

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 29973
	:	
Thomas DISTEFANO III	:	Confirmation Number: 8542
	:	
Application No.: 09/589,551	:	Group Art Unit: 3622
	:	
Filed: June 7, 2000	:	Examiner: D. Lastra
	:	
For: METHOD FOR DEVELOPING ELECTRONIC DOCUMENTS PROVIDING E-COMMERCE TOOLS	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated February 4, 2008.

The Examiner's response to Appellant's arguments submitted in the Appeal Brief of November 19, 2007, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellant relies upon the arguments presented in the Appeal Brief of November 19, 2007, and the arguments set forth below.

REMARKS

At the outset, before addressing the Examiner's response to Appellant's arguments presented in the Appeal Brief, Appellant notes that the Examiner has submitted a non-compliant Examiner's Answer. As is evident from the extensive comments presented by Appellant during prosecution of the present Application and in the Appeal Brief, there are questions as to how the limitations in the claims correspond to features in the applied prior art. In this regard, reference is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the following is stated:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(9)(c) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. (emphasis added)

However, upon reviewing the Examiner's Answer, Appellant notes a lack of a section within the Examiner's Answer that meets the requirements described in the aforementioned section. Thus, the Examiner's Answer is non-compliant and further evidences the Examiner's continued failure to clearly identify the features within the prior art being relied upon by the Examiner in rejecting the claims and continued failure to clearly explain the pertinence of the applied prior art, as required by 37 C.F.R. § 1.104(c).

On pages 5 and 6 of the Second Appeal Brief, Appellant presented arguments as to the Examiner's general failure to clearly identify many of the specific elements within Mason being relied upon in the rejection. Upon comparing the Examiner's statement of the rejection on pages 3-14 of the Fourth Office Action, with pages 3-14 of the Examiner's Answer, Appellant has been unable to discover and substantial changes in the Examiner's statement of the rejection. Thus, the Examiner has not addressed Appellant's arguments.

In response to the arguments presented on pages 6 and 7 of the Second Appeal Brief, the Examiner initially asserted the following on page 15 of the Examiner's Answer:

The Examiner answers that Mason teaches in col 3, lines 55-65 "Once displayed on a website, the derivative ads are actually derivative ad links since a person viewing the derivate ad links can click on these links in order to be connected to a website established by the national advertiser. For example, upon clicking a derivate ad link for a national soup company, a potential customer may be connected with the home page of that soup company or to some other **website specifically designed** for use in connection with that advertising campaign". Therefore, contrary to Appellant's argument, during an advertisement campaign an advertiser in the Mason's system is concerned with the design of a first website specifically designed for use in connection with a banner ad (*i.e.* "derivative banner ads"; col 3, lines 55-65), said advertiser is also concerned during said advertisement campaign with the design of a banner ad concerning said first website (see Mason col 3, lines 25-40; "advertiser art director review the banners ads before publishing in different websites") and said advertiser is also concerned during said advertisement campaign with publishing said advertiser's banner ad (*i.e.* "derivative ad links") concerning said first website on a second website (*i.e.* "single banner ad is automatically reconfigured for placement on hundreds of online newspaper URLs in a single placement" see Mason col 6, lines 1-6). (emphasis in original)

The Examiner's assertion that "said advertiser is also concerned during said advertisement campaign with the design of a banner ad concerning said first website" is entirely speculative. As taught by Mason, the other website is specifically designed for an advertising campaign and not a banner ad concerning the website.

The Examiner's arguments appear to be factually unsupported inherency arguments. Inherency may not be established by probabilities or possibilities. The mere fact that a certain

1 thing may result from a given set of circumstances is not sufficient to establish inherency.¹ To
2 establish inherency, the extrinsic evidence must make clear that the missing elements must
3 necessarily be present in the thing described in the reference, and that the necessity of the
4 feature's presence would be so recognized by persons of ordinary skill.²

5
6 As can be readily envisaged, the design of the "other website specifically designed for
7 use in connection with that advertising campaign," as taught by Mason, could have occurred
8 prior to the creation of the banner ads. In fact, the other website could have been created first,
9 which would preclude information as to the banner ads being received during the design of the
10 other website.

11
12 As described in column 3, lines 28-35 of Mason, "that original advertisement is used to
13 form derivative advertisements ... [t]he properly configured derivative advertisements are then
14 transmitted to the desired [websites] for display on those websites as derivative links." Based
15 upon this teaching, the derivative advertisements (i.e., the Examiner's alleged banner ads) are
16 formed later on in the process (i.e., the banner ads are derived from original advertisements). On
17 the contrary, as claimed, information regarding the "element for marketing" (i.e., allegedly
18 disclosed by the banner ads) is received during the design of the first website. Thus, Mason
19 appears to be teaching the opposite of what is claimed. These arguments notwithstanding, the
20 Examiner's inherency arguments cannot stand since the Examiner has failed to establish that the

¹ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

² Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

Examiner's alleged teachings are necessarily present in Mason, which is required for a finding of inherency.

On pages 6 and 7 of the Appeal Brief, Appellant made a specific argument as to the Examiner improperly characterizing the differences between the claimed invention and the prior art. On pages 15 and 16 of the Examiner's Answer, the Examiner responded as follows:

Furthermore, Appellant's claimed limitation "during design of the first website ... causing the display of the element for marketing at the second website when the first website is activated with the respect to the Internet, wherein the element of marketing includes at least one banner ad concerning the first website and a link to the first website" is interpreted in light of Appellant's specification page 33, lines 10-15 where it recites "Once the design of the new website by the registered user is completed and the new website is posted/activated, the system 100 causes the selected websites of other registered users (e.g., websites selected during the design of the new website) to display a link and/or banner ad concerning the new website" as simply meaning that a banner ad concerning a first website would be displayed on a second website when said first website is completed and activated on the Internet.

Again, the Examiner mischaracterizes the claimed invention. The "during design of the first website" limitation is not associated with the "causing the display of ..." limitation. Moreover, the passage in Appellant's specification cited by the Examiner does not support the Examiner's interpretation. This passage states that once the design is completed and the website is posted/activated, then link and/or banner ad is displayed. As evidenced by this passage, the "causing the display of ..." does not occur "during the design of ..." since the "causing the display of" occurs after the design is completed.

The Examiner's obviousness assertions on page 16 rely upon the Examiner's factually-unsupported allegations that "a first website [was] specifically designed for use in connection with said banner ad in said advertisement campaign."

On pages 6 and 7 of the Second Appeal Brief, Appellant presented arguments which concluded that "the Examiner has failed to establish that either Moore or Mason has identified a problem in which a common sense solution to that problem would lead to the Examiner's proposed benefit" (i.e., "avoid posting banner ads in websites which would not provide any click-throughs revenue"). The Examiner's response to these arguments is found on pages 16 and 17 of the Office Action and reproduced below:

It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that publishing an advertiser's banner ad concerning a first website on a second website in an advertisement campaign would cost money to said advertiser (see Mason col 5, lines 5-30 "by the number of click-throughs") and if said banner ad concerning said first website is published on said second website without said first website being activated with respect to the Internet, said advertiser would be paying every time a user clicks said banner ad (i.e. "by the number of click-throughs") but without said clicking bringing any business to said advertiser, as said banner ad would be pointing to a non-activated and therefore, non-existing first website with respect to the Internet. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the activation of a first website would cause a banner ad concerning said first website to be displayed on a second website as Moore teaches that it old and well known in the promotion art to display a banner ad concerning a first website on a second website when said first website is activated with respect to the Internet (i.e. "Price URLs have to be included on the site or elsewhere"; see Moore col 8, lines 55-65). Therefore, contrary to Appellant's argument, Appellant's claimed invention is obvious in view of Mason and Moore. (emphasis in original)

The Examiner did not respond to the arguments presented by Appellant. Instead, the Examiner merely restated the Examiner's prior position.

Moreover, Appellant notes that the Examiner has improperly manufactured both a problem (i.e., "advertiser would be paying every time a user clicks said banner ad ... but without said clicking bringing any business to said advertiser") and a solution (avoid displaying, on a second website, banner ads to a first website when the first website has not been activated) based upon the simple teaching that an advertisers can purchase advertising based upon a number of click-throughs. Not only is the Examiner's problem/solution not supported by the teachings of

the prior art, the Examiner's problem statement relies upon assumptions that have yet to be factually supported. Specifically, the Examiner has yet to factually establish that a click on a banner ad to a non-activated website would be treated as a "click-through" and/or would count against the number of click-throughs purchased by the advertiser. Without factually establishing that clicks on a non-functional banner ad will count against the number of click-throughs purchased by an advertiser, the Examiner cannot assert that this would be a problem. Thus, Appellant maintains that the Examiner's obviousness analysis is factually unsupported.

In the first full paragraph on page 8 of the Second Appeal Brief, Appellant presented arguments which concluded that absent from Moore is any teaching regarding causing the display of the element for marketing at the second website when the first website is activated with respect to the internet, as claimed. The Examiner's response to these arguments is found in the last full paragraph on page 17 of the Examiner's Answer and reproduced below:

The Appellant argues in page 8 of the Brief that Moore does not teach any teaching regarding causing the display of the element for marketing at the second website when the first website is activated with respect to the Internet. The Examiner answers that Moore reference teaches that it is old and well known in the promotion art to have applications that allow users to design a website and a banner ad (i.e. "Price URLs") (see Moore col 3, lines 22-30) and that allows users to publish said banner ad (i.e. Price URLs) on said website or elsewhere (i.e. "another website" see Moore col 8, lines 55-60) when said website is activated on the Internet (see Moore col 8, lines 55-60). Therefore, contrary to Appellant's argument, Moore teaches causing the display of the element for marketing (i.e. Price URL) at the second website when the first website is activated with respect to the Internet. (emphasis in original)

For ease of reference, the Examiner cited passage within Moore of column 8, lines 55-60 is reproduced below:

The only restriction is that the price URLs, which allow the Store Builder Server to build the Buy Pages, have to be included on the site, or elsewhere, in order for the Web customer to place an order. The merchant can even totally remove the Web storefront, and simply post the price URLs on news groups or on another web site.

Completely absent from this passage is any mention of activation of the first website with respect to the internet. Therefore, yet again, the Examiner is improperly inferring teachings from the applied prior art that cannot be found, either explicitly or inherently, in the applied prior art.

On pages 8 and 9 of the Second Appeal Brief, Appellant presented arguments as to the Examiner's improper assertion that the terms "posted" and "activated" are equivalents. Appellant previously presented these arguments in the First Appeal Brief, but the Examiner did not respond to these arguments in the Fourth office Action. The Examiner purports to address these arguments in the first full paragraph on page 18 of the Examiner's Answer. However, the Examiner "response" simply restates the Examiner's position without addressing the specific arguments raised by Appellant in both the First and Second Appeal Briefs.

Regarding claim 4, Appellant presented arguments that the combination of Mason and Moore fail to teach the limitations recited in claim 4. The Examiner's response to these arguments are found in the paragraph spanning pages 19 and 20 of the Examiner's Answer. In part, the Examiner asserted the following:

Therefore, the limitation "reciprocal site" simply means, according to Appellant's specification, providing a space in a website such that third parties can place their ads in said website. Moore teaches in figure 7 the design of a website which includes a reciprocal site, where the links of another Internet website can be displayed on said reciprocal site (see figure 7 "enter website URL"). Mason teaches that it is old and well known in the promotion art for advertisers to sell advertising space in their websites (see Mason col 5, lines 5-30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers of a first website specifically designed for use in connection with a banner ad would also sell advertising space in said advertiser's first website, where advertisements would be placed in a reciprocal site in said first website, such as the one taught by Moore and where said advertisers would sell advertising space in said reciprocal site on said website to third party

advertisers as taught by Mason in order that said advertisers of said first website would generate revenue for said selling of said reciprocal site advertising space.

Appellant respectfully submit that the Examiner's claim construction completely ignores the term "reciprocal." The term "reciprocal site" does not simply mean a place in a website such that third parties can place their ads, as asserted by the Examiner. A reciprocal site refers to reciprocity. This concept, however, has not been addressed in the Examiner's analysis.

In response to Appellant's arguments on page 11 of the Second Appeal Brief that a review of the passages and figures within Moore cited by the Examiner fail to yield any mention of a banner ad, the Examiner asserted the following in the last full paragraph on page 21 of the Examiner's Answer:

The Appellant argues in page 11 of the Brief with respect to claim 8 that Moore does not Appellant's claim 8 because according to the Appellant, Moore fails to yield any mention of a banner ad. The Examiner answers that Moore's price URLs (see col 6, lines 10-20) is an element for marketing such as a banner ad because when a user clicks said price URL, said user is connected to another site where said user can order an advertiser's product (see col 12, lines 1-25). Furthermore, Moore discloses that said Price URL have to be included on the advertiser site or elsewhere (i.e. "another website") in order for the customer to place an order (see Moore col 8, lines 47-60). Therefore, contrary to Appellant's argument, Moore teaches the limitation "banner ad".

The teaching of a "Price URL" does not disclose a banner ad. As would be readily recognized by one having ordinary skill in the art, these are two different features. The Examiner has the burden of establishing that one having ordinary skill in the art would recognize that a Price URL corresponds to the claimed banner ad, yet the Examiner has failed to make this showing. Appellant also notes that the Examiner has failed to establish that the applied prior art teaches any of the other elements recited in claim 8.

In response to Appellant's arguments on page 12 of the Second Appeal Brief that that applied prior art fails to teach the limitations recited in claims 9 and 10, the Examiner asserted the following on page 22 of the Examiner's Answer:

The Appellant argues in page 12 of the Brief with respect to claim 9 that Moore is silent as to display regions and thus according to the Appellant, cannot teach the claimed first and second display region. The Examiner answers that Moore teaches in figure 7 different display regions (i.e. "welcome, categories, head/foot, new page, preview") that users of said Moore's system would use in order to design a website, where said first (i.e. "head/foot") and second display regions (i.e. "preview") are capable of displaying a plurality of elements. Therefore, contrary to Appellant's argument, Moore teaches Appellant's "display regions" limitation.

The Appellant argues in page 12 of the Brief with respect to claim 10 that Moore is silent about "sonic effect". The Examiner answers that Moore teaches a system that allows users to design websites using a development tools where merchants can search for images and logos that said merchants want to include in their websites (see col 11, lines 35- 50). Furthermore, Moore teaches that it is old and well known in the promotion art to add audio to websites (see Moore col 1, lines 35-40). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Moore would add URL links to images (see col 11, lines 45-50) that would connect users to audio files, as it is old and well known to add audio to websites.

The Examiner's response ignores the broad scope of Appellant's arguments. The Examiner's statement of the rejection in the Fourth Office Action and the Examiner's Answer ignores most of the claimed limitations. For claim 9, the Examiner asserts "the same rejection applied to claim 8 is also applied to claim 9" despite the limitations in claim 9 not being comparable to the limitations in claim 8. As to claim 10, the Examiner asserts that Moore teaches add audio and multimedia files to a website but is silent as to the specific steps recited in claim 10.

Although the Examiner attempted to identify certain of the limitations specifically identified by Appellant, the Examiner has still failed to establish that the applied prior art teaches all of the claimed limitations recited in claims 9 and 10.

1 Regarding claim 13, many of the elements recited in claim 13 have been addressed with
2 regard to claim 1. The Examiner's assertions in the paragraph spanning pages 22 and 22 are
3 comparable to the assertions presented with regard to claim 1 and addressed by Appellant above.
4 Appellant, therefore, respectfully incorporates herein, as applying to claim 13, the arguments
5 previously presented with regard to claim 1.

6

For the reasons set forth in the Appeal Brief of November 19, 2007, and for those set forth herein, Appellant respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 503839, and please credit any excess fees to such deposit account.

Date: April 4, 2008

Respectfully submitted,

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